

verifying that upon allowance of the linking claims, the restriction of claims 1-28 and 37-40 will be withdrawn and that the claims will be examined as indicated in MPEP 809.03.

Claims 1-28 and 37-40 are directed to N-propionated saccharide conjugated to protein at the beta position of the propionate moiety. Claims 29-36 relate to methods of making such conjugates, and claims 41-58 relate to methods of using the conjugates and antibodies produced by the conjugates. Restriction of the subject matter of these claims is improper.

Claim 1 describes N-propionated saccharide conjugated to protein at the beta position of the propionate moiety. Dependent claims 2-14 further describe the saccharide and protein. Restriction of the subject matter of dependent claims 2-14 is improper because all of these claims are dependant on proper generic claim 1 and necessarily contain all the elements of claims 1. MPEP 806.04(d). Thus, restriction to one of: *E. coli*, Meningococcus, Pneumococcus, Streptococcus, Haemophilus, Neisseria, Salmonella, Klebsiella, or Pseudomonas is improper.

A reasonable number of species may be claimed in one application. MPEP 806.04(a). A reasonable number of species may be specifically claimed in one national application, provided the application also includes an allowable claim generic to all the claimed species, and all the claims to species are written in dependent form. 37 C.F.R. § 1.141. The nine saccharide species described in claim 4 is a reasonable number of species. Claim 4 is dependent on generic claim 1. Restriction to one of the nine saccharide species is, therefore, improper. The same argument holds for claims 2,3, and 5-14.

The general test as to when claims are properly restricted to different species requires that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. MPEP 806.04(f). The fact that the nine saccharide species are

described in a Markush claim, which necessarily recites the same limitations for every species, shows that, in this case, restriction to a single species is improper.

At most, a proper restriction would be a requirement to provisionally elect one species from a Markush claim. A Markush-type claim can include independent and distinct inventions whose members are so unrelated and diverse that a prior art reference anticipating the claims with respect to one of the members would not render the claim obvious with respect to the other members. MPEP 803.02. In such a case, the Examiner may only require a provisional election. *Id.* If the elected species is novel and non-obvious, the full scope of the claim must then be fully examined. *Id.* Thus, the current restriction requirement, which does not indicate that the restriction requirement is provisional, is improper.

Finally, the Examiner's 53 way restriction requirement does not encompass claims 19 and 20.

Thus, according to current practice before the Patent Office, any restriction of the subject matter of claims 1-28 and 37-40 is improper and should be withdrawn. Applicants respectfully request reconsideration and withdrawal of all restrictions to the subject matter of claims 1-28 and 37-40.

Claims 29-36 are directed to a method of making a  $\beta$ -propionamido-linked saccharide protein conjugate. These claims are related to composition claims 1-28 and 37-40, and the examination of claims 29-36 would require little, if any, further searching or consideration to be properly examined. Thus, examination of these claims would not be an undue burden on the Examiner. Withdrawal of the restriction of claims 29-36 is respectfully requested.

Claims 41-47 are directed to methods of immunizing or eliciting an antibody response using the compositions described in claims 1, 16 or 37. Claims 48-54 are directed to

antibodies elicited by the compositions of claims 1 or 16, and claims 55-58 are directed to the use of these antibodies to provide passive immunity. The subject matter of these claims is closely related to the subject matter of the invention of claims 1-40. In fact, claims 41-58 are dependent on claims 1-40. Thus, examination of these additional claims would not be an undue burden on the Examiner. Withdrawal of the restriction of claims 41-58 is respectfully requested. If the Examiner maintains the restriction requirement, applicants request that the restriction requirement be made final so applicants can pursue other appropriate action.

AUTHORIZATION

No additional fee is believed due in connection with this paper. However, should any additional fees be required, the Commissioner is hereby authorized and requested to deduct any additional required fees from Deposit Account No. 13-4500, Order No. 3842-4043US1.

Respectfully submitted,

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